UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte EVGENIY M. GETSIN, MICHAEL J. LEWIS, TODD R.
COLLART, and ALLAN B. LAMKIN

_____

Appeal 2009-004873[1]
Application 09/489,597
Technology Center 2100

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Decided: December 9, 2009

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Before JEAN R. HOMERE, JAY P. LUCAS, and THU A. DANG,
Administrative Patent Judges.

HOMERE, *Administrative Patent Judge.*

DECISION ON APPEAL

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[1] Filed January 20, 2000. The real party in interest is Sonic Solutions. (App.
Br. 2.)

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the
Examiner's final rejection of claims 1 through 18. (App. Br. 4.) We have
jurisdiction under 35 U.S.C. § 6(b) (2008).

We affirm.

Appellants' Invention

Appellants invented a method and system for synchronizing the
playback of a multimedia event on a plurality of client devices. (Spec. 1, ll.
9-11.) As depicted in Appellants' Figures 9 and 10, upon receiving a request
from each of the client devices to simultaneously playback the event, a host
server identifies the type of playback device for each of the clients to thereby
look up a command associated therewith. (Spec. 32, l. 1 – 33, l. 16.) The
host server then sends the command to those clients that submitted their
request prior to a predefined period of time to instruct them to
simultaneously playback the event. The host server subsequently sends the
command to those clients that submitted their request after the predefined
period of time to instruct them to simultaneously playback the event at a
predetermined point during the initial playback. (*Id*. at 30, ll. 19-32.)

Illustrative Claim

Independent claim 1 further illustrates the invention. It reads as
follows:

> 1 : A method for identifying playback devices of a
> plurality of client apparatuses which are networked to
> simultaneously playback an event, comprising the steps of:

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receiving requests from each of the client apparatuses to simultaneously playback the event;

identifying a type of the playback device of each of the client apparatuses;

looking up a command associated with the identified type of the playback device;

determining whether each request is received during a predefined threshold period prior to a start time of initially beginning the simultaneous playback of the event; and

sending the command to the corresponding client apparatus for initially beginning the playback of the event at the start time simultaneously with the playback of the event on each of the remaining client apparatuses for those requests received during the predefined threshold period, and sending the command to the corresponding client apparatus for beginning the simultaneous playback of the event simultaneously at a predetermined point during the playback for those requests not received during the threshold period.

<div align="center">*Prior Art Relied Upon*</div>

The Examiner relies on the following prior art as evidence of unpatentability:

Craig	6,108,687	Aug. 22, 2000
Roberts	6,161,132	Dec. 12, 2000

<div align="center">*Rejection on Appeal*</div>

The Examiner rejects the claims on appeal as follows:

Claims 1 through 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Roberts and Craig.

Appellants' Contentions

Appellants contend that the combination of Roberts and Craig does not teach (1) looking up a command associated with the identified type of each device requesting to simultaneously playback an event, and (2) sending the looked up command to the requesting devices that submitted their requests during a predefined period of time prior to the start of the playback of the event, as recited in independent claim 1. (App. Br. 15-22.) According to Appellants, at best, the combination would allow participants of a chat room to be able to establish their connections with an active chat room prior to a lecture beginning. (*Id.* at 14.) However, Appellants argue that the proffered combination does not teach or suggest receiving requests prior to the event (chat room) and there would be no reason to determine whether the requests are received prior to the event because Roberts' chat room is started immediately upon receiving the first request. (*Id.*) Further, Appellants argue that while Robert discloses determining the capabilities of a CD drive, such disclosure cannot be equated with looking up commands associated with the types of playback devices thereby sending such commands to associated client devices. (*Id.* at 15.)

Examiner's Findings

The Examiner finds that Craig's initiation of a slide presentation session teaches a predefined threshold period, and the actual presentation teaches the start of the simultaneous playback of events. (Ans. 11.) The Examiner further finds that Roberts' disclosure of a command plug-in that

gathers information about the capabilities of a CD drive teaches determining the type of command associated with a playback device. (*Id.* at 12.)

II. ISSUE

Have Appellants shown that the Examiner erred in concluding that the combination of Roberts and Craig teaches or suggests looking up a command associated with the identified type of each client device requesting to simultaneously playback an event and sending the retrieved command to corresponding client devices that submitted their requests during a predefined period of time prior to the start of the playback of an event in order to simultaneously playback the event thereon, as recited in independent claim 1?

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Roberts

1.   Roberts discloses a system for synchronizing the playback of a recording on networked computer systems. (Title.) As shown in Figure 1, Roberts discloses a computer program running on a remote host (16) that can control the CD player (32) on a user computer (10). (Col. 2, ll. 5-14.) Roberts's system is used to provide participants in a chat room with the same music at approximately the same time. (Col. 6, ll. 62-65.)

2.   The computer program employs a command plug-in to acquire information about the capabilities of the CD drive, as well as performing various controlling functions on a CD detected in the drive. (Col. 4, ll. 1-16.)

3.   Upon detecting a CD in the drive of the user's computer, the command plug-in uses a script to assign a unique identifier (ID) to the CD including each recording contained thereon. The unique ID of the CD is sent to a server database to retrieve further information about the CD (e.g., name of artist, song title, length of tracks, video clips, photographs.) (Col. 6, ll. 21-48.)

4.   If the user computer with the detected CD is a chat client, the server employs the unique ID of the CD to determine if a chat room is focused on the CD. If so, the server the server allows the chat client to participate in that chat room. The server provides to all chat room participants the name of the chat room, and other information about the CD being played (e.g., track being played, playing time). The chat client command plug-in controls the CD of each chat room participant in such a way to synchronize it among the chat room participants during the simultaneous playback of the CD. (Col. 7, l. 11- col. 8, l. 2.)

Craig

5.   Craig discloses a system for synchronizing the presentation of remote lecture slides between networked computers. (Abst.) As shown in Figure 3, upon an instructor (70) executing an applet (71) at a lecture server

(76) to initiate the presentation of a lecture prior to its scheduled to start time, student participants (72, 74) are given a period of time to connect to the initiated lecture session. Once connected to the session, the students will be able to follow the presentation of the slides simultaneously with the instructor after it begins. (Col. 12, ll. 7-21.)

> 6. If the lecture is already under way, once connected, the students are provided with the current slide number in order to catch up with rest of the class. (Col. 12, ll. 22-29.)

IV. PRINCIPLES OF LAW

Obviousness

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

> Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

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In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art" and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 401 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966)) (citation omitted). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 415, 417.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 416). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 550 U.S. at 418).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See Kahn*, 441 F.3d at 987-988; *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991); *In re Keller*, 642 F.2d at 425. Moreover, in evaluating such references it is proper to take into account "not only [the] specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." *In re Preda*, 401 F.2d 825, 826 (CCPA 1968) (citation omitted).

V. CLAIM GROUPING

Appellants argue the patentability of claims 1 through 18 in conjunction with the rejection of independent claim 1. In accordance with 37 C.F.R. § 41.37(c)(1)(vii), we will consider these claims as standing and falling respectively with claim 1.

VI. ANALYSIS

Independent claim 1 requires, in relevant parts, (1) looking up a command associated with the identified type of each client device requesting to simultaneously playback an event, and (2) sending the retrieved command to corresponding client devices that submitted their requests during a predefined period of time prior to the start of the playback of an event in order to simultaneously playback the event thereon. (App. Br. 29, Claims App'x.)

As set forth in the Findings of Fact section, Roberts discloses using a command script to determine the capabilities of a CD drive detected in user's computer, as well as to control the CD contained therein. (FF. 2.) Further, Roberts discloses using a unique ID for the detected CD to look up a chat room focused thereon, as well as other chat room participants that contain the same CD in their computer drives. (FF. 3-4.) Roberts also discloses synchronizing the playback of recordings on the CD among chat room participants. (FF. 1 and 4.) Additionally, Craig discloses allowing students to simultaneously playback the slides presentation with an instructor if they submitted their requests to do so after the instructor has initiated the presentation and prior to start of the lecture. (FF. 5.)

We agree with the Examiner's finding that the Roberts' disclosure of identifying the CD drive capabilities entails, *inter alia*, identifying the type of the CD drive, which is a client playback device. (Ans 12.) Further, we find that Roberts' disclosed script command is instrumental in identifying the content of the detected CD in the individual computers of chat room participants, as well as in matching the contents of the detected CD to a focused chat room. We thus find that Roberts' disclosure teaches using a command to determine looking up the recordings of a CD associated with identified CD drives in a chat room, and further teaches issuing a command to synchronize the simultaneous playback of the CD recordings among the chat room participants. Additionally, we find that Craig's disclosure of allowing the students to simultaneously playback a slide presentation, if they requested to connect to the presentation server after the instructor

presentation initiation and before the lecture is scheduled to start, teaches allowing the students who submitted their request during a predefined threshold period prior to the lecture to simultaneously playback the lecture. We consequently find that Roberts and Craig disclose prior art elements that perform their ordinary functions to predictably result in a system that uses a script command to identify recordings in the CD drives of chat room participants that requested to connect to the chat room prior to the start of the CD being played back simultaneously. We therefore do not agree with Appellants' contention that there is insufficient rationale for combining the teachings of Roberts and Craig. (App. Br. 25.)

Further, we do not agree with Appellants' argument that Roberts teaches away from Craig. (App. Br. 19.) Appellants incorrectly refer to the chat room connection in Roberts or the connection to the lecture server in Craig as being the playback event. We find the playback event in Roberts to be the playing of the CD in the chat room. Similarly, we find the playback event in Craig to be the playing of the lecture slides in the network. Both systems aim at synchronizing the simultaneous playback of the identified event for a plurality of clients. It follows that Appellants have not shown that the Examiner erred in concluding that the combination of Roberts and Craig renders independent claim 1 unpatentable.

VII. CONCLUSION OF LAW

Appellants have not established that the Examiner erred in rejecting claims 1 through 18 as being unpatentable under 35 U.S.C. § 103(a).

VIII. DECISION

We affirm the Examiner's rejection of claims 1 through 18.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

<u>AFFIRMED</u>

nhl

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